

U.S. GOVERNMENT PRINTING OFFICE, WASH., D. C.

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CHARLES ELMORE DROPLEY
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(1D)
IN THE

Supreme Court of the United States

OCTOBER TERM 1944

No. 1283

JERRY VOGEL MUSIC CO., INC.,

Petitioner,

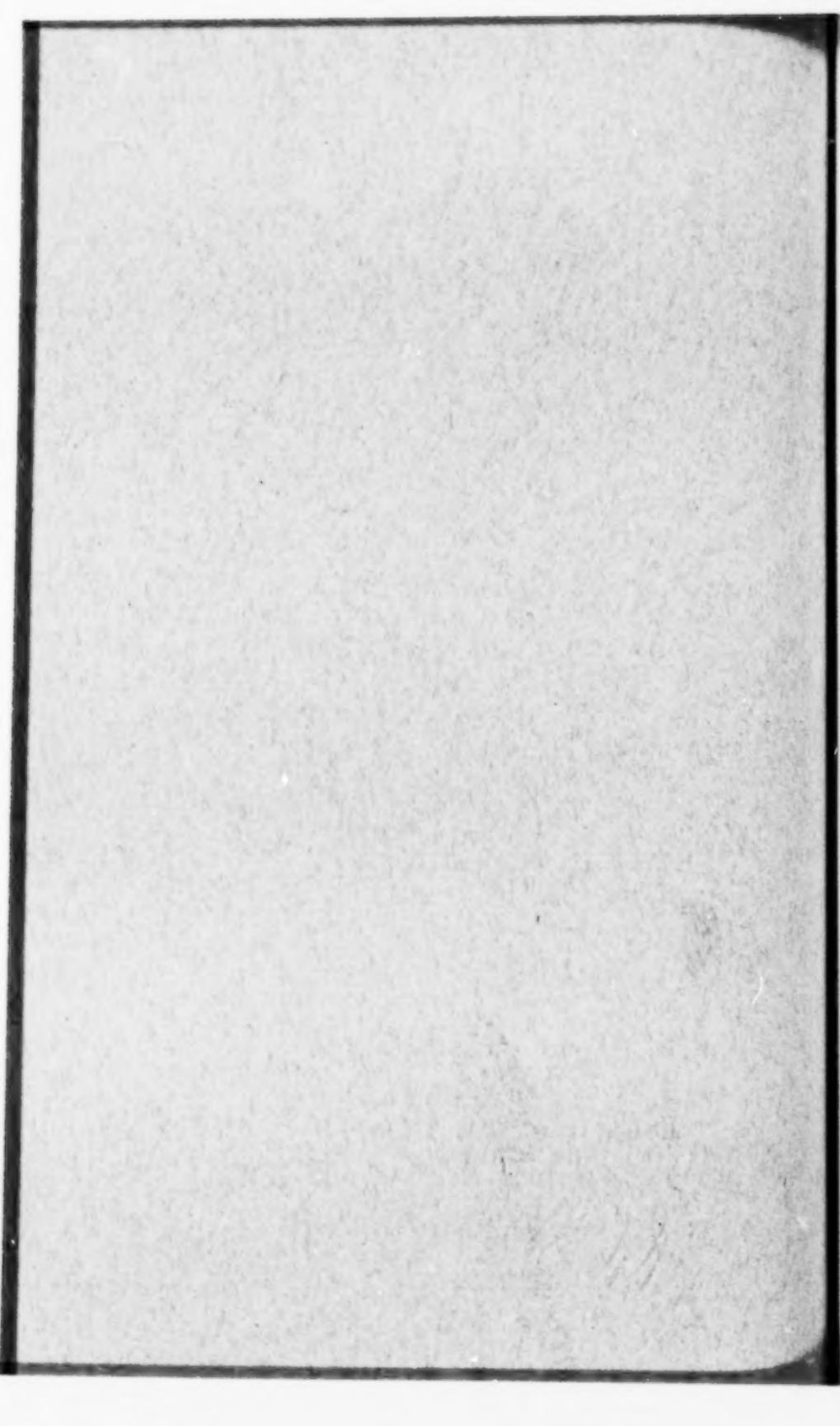
against

FORSTER MUSIC PUBLISHERS, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF AP-
PEALS FOR THE SECOND CIRCUIT
WITH SUPPORTING BRIEF

ARTHUR F. DRISCOLL,
Solicitor for Petitioner.



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**PETITION FOR A WRIT OF CERTIORARI TO THE
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*To the Honorable, the Chief Justice of the United States
and the Associate Justices of the Supreme Court of
the United States:*

Your petitioner, Jerry Vogel Music Co., Inc., after final judgment in the above cause, wherein petitioner was defendant and respondent was plaintiff, respectfully prays that a writ of certiorari issue to review the judgment of the United States Circuit Court of Appeals for the Second Circuit entered in this case on March 19, 1945.

I**Summary Statement of Matter Involved.**

The action was begun March 13, 1939 by the filing of a complaint in the District Court, Southern District of New York (R. p. 2). It involves the ownership of copyright for the renewal term of the musical composition entitled "Down by the Old Mill Stream".

The plaintiff, a music publisher, sought a declaratory judgment, claiming sole ownership through assignment from the next of kin of one Tell Taylor, deceased, affirmatively alleging that Taylor had been the sole author, and that Earl K. Smith, assignor of defendant, was not a co-author.

The defendant, also a music publisher, entered its denial of the plaintiff's claim.

Thus, the case proceeded to trial with the issue of authorship being squarely presented, the plaintiff having the burden of proving under the pleadings, not only that Taylor was the sole author but that Smith was not a co-author.

The Trial Court concluded plaintiff was the owner of the renewal term of copyright, holding that Taylor had been the sole author; that Smith had never asserted a formal claim of co-authorship during the original term and therefore was barred from asserting a right to the renewal.

District Judge Mandelbaum's opinion appears at pages 111 to 115 of the record.

The Trial Court's judgment was affirmed by the United States Circuit Court for the Second Circuit, with opinion by Judge Simons, which appears at pages 123 to 128 of the record and is reported in 147 Fed. (2d) 614. A petition for rehearing was denied March 19, 1945.

II**Facts.**

In 1910 Tell Taylor, a music publisher, registered in the Copyright Office a claim of copyright for the musical composition, which stated that the words and music were by Taylor, and that it was published by Star Music Publisher (R. Ex. 1).

Taylor simultaneously filed two printed copies of the original edition. There was printed on the music page of those copies the names of Earl K. Smith and Tell Taylor, as writers, not Taylor alone (R. Exs. A and B).

Smith's name was on the entire first edition. It was removed from the subsequent editions. There is no explanation in the record for such removal.

Taylor was the Star Music Publisher. He obtained the copyright, controlled the printing, and published the first edition. The printing of Smith's name as co-author therefore was an admission by Taylor that Smith was co-author.

Smith, as co-author, during the last year of the original term of copyright, filed a notice of renewal and extension. Two weeks later Taylor filed a notice of renewal and extension. Taylor died before the expiration of the last year of the original term.

Plaintiff, urging that under Section 55 of the Copyright Law the original copyright certificate was *prima facie* proof of sole authorship by Taylor, offered in evidence such certificate and rested its case. This certificate states (Ex. 1):

1. That two copies of the musical composition had been filed; and
2. That registration of a claim of copyright for the first term of 28 years had been made by Taylor—Words and Music by Tell Taylor.

Defendant, taking issue, contended: (a) That such certificate was only *prima facie* proof of the facts certified therein, namely, that two copies of the musical composition were filed in the Copyright Office, and that Taylor had registered a claim for copyright thereon; and (b) That the two filed copies of the musical composition as originally published were part of the copyright record, and as Smith's name was on such copies as co-author, they constituted a formal admission by Taylor that Smith was a co-author. Such admission met the plaintiff's *prima facie* proof and overcame any presumption of sole authorship by Taylor that might have arisen by the introduction of the original certificate of copyright, if as a matter of law the certificate carried such presumption.

Defendant called Smith to testify and his testimony was excluded under Section 347 of the New York Civil Practice Act, known as the "Dead Man's Statute".

III

Statement of Jurisdiction.

The jurisdiction of this Court is invoked under the provisions of Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C., Sec. 347(a)), and Section 23 of the Copyright Law (17 U. S. C., Sec. 23).

Cases believed to sustain the jurisdiction are:

Fox Film Corp. v. Knowles, 261 U. S. 326;
Witmark v. Fisher, 318 U. S. 643.

IV**Questions Presented.**

The case presents important questions arising under the United States Copyright Law (17 U. S. C.) relating particularly to the renewal term of copyright as provided for by Section 23 of that law. These questions, arising in a suit purporting to be one for a declaratory judgment, are:

1. Whether or not, in determining ownership of the renewal term of copyright, the original certificate of copyright raises a presumption of authorship under Section 55 of the Copyright Law, or whether such certificate, in the words of that section, is merely *prima facie* proof of the facts certified or stated therein, namely, that (a) two copies of the work were filed, and (b) that registration of a claim of copyright for the first term on said work has been made.
2. Is an author properly barred from claiming ownership in the renewal term of copyright by reason of his failure to assert formal claim of ownership of the original term of copyright?
3. Can a co-author of a musical composition, in defending a claim that he is not a co-author, be prevented from testifying that he was such co-author and, therefore, entitled to share in the renewal term of copyright, by the assignee of the heirs of the other co-author invoking Section 347 of the New York State Civil Practice Act, known as the so-called "Dead Man's Statute"?
4. If the original certificate of copyright, containing the unsworn statement of Taylor (since deceased) that he was author of the musical composition, is accepted as *prima facie* evidence of his sole authorship, does

such acceptance waive the incompetency of the other co-author to testify under Section 347 of the New York State Civil Practice Act?

V

Reasons for Granting the Writ.

Petitioner urges the following reasons for granting the writ of certiorari:

1. The decision below is of the utmost importance to the music publishing business.
2. It places the burden upon a surviving co-author of establishing that he is a co-author, while at the same time, in the event that the plaintiff has taken title from a co-author now deceased, it gags the survivor under Section 347 of the New York State Civil Practice Act.
3. It accepts as equivalent to testimony by the deceased an unsworn claim by him to sole authorship, yet it fails to consider such acceptance as a waiver of the incompetency of the co-author to testify under the provisions of Section 347 of the New York State Civil Practice Act.
4. It is authority for the proposition that an author cannot assert claim to the renewal term of copyright unless he had an established right to the original term of copyright. It is respectfully submitted that the purpose and intent of the Congress in framing the Copyright Law was to preserve to the author a right to secure the renewal or extended term regardless of whether or not he had any interest in the original term of copyright.
5. It gives to the copyright certificate the status of *prima facie* evidence not only of the facts certified therein as per the provisions of Section 55 of the Copyright Act, but also

prima facie evidence as to facts stated by a fellow co-author even though not under oath or substantiated by official seal.

That the above are true is borne out by a circular issued by the Music Publishers' Protective Association, Inc., to all its members under date of February 27, 1945.

The importance of this decision to the music publishing industry and to the writers of popular songs is well illustrated by the said circular, which refers entirely to the decision in this case. It opens with the following statement:

"Mr. Julian Abeles, counsel for the appellee, kindly furnished us with the following explanatory memorandum:"

There then follows three pages of quotation of the memorandum furnished by counsel for the plaintiff below. Among other things, Mr. Abeles says:

"A decision of utmost importance to the music publishing companies which were acquired in recent years by new interests, has just been handed down by the Circuit Court of Appeals in the 'Down by the Old Mill Stream' case."

He also says:

"In the 'Mill Stream' case Forster Music Publisher, Inc. had acquired the renewal copyright from Tell Taylor as the sole writer. Earl K. Smith, who claimed to be a co-writer, had likewise had a renewal registered in his name and assigned the renewal rights to Jerry Vogel Music Co. Inc. Forster, through his attorney, Julian T. Abeles, brought an action in the New York District Court, in which it asked the Court to declare that it was the sole owner of the renewal rights."

Mr. Abeles then details the establishing of a prima facie case by offering the certificate of copyright and the blocking of Smith's testimony by invoking the "Dead Man's Statute". He says:

"While the original copyright certificate stated that Taylor was the sole author, printed copies of the song which were filed in Washington and sold, bore the name of Smith as the co-writer with Taylor."

Mr. Abeles' next sentence is very illuminating:

"Taylor having died, Forster was in the unfortunate position of being unable to explain why Smith's name had been placed on the copies if he was not a co-writer."

Mr. Abeles then explains how he met the situation:

"Abeles was accordingly obliged to rest his case upon the copyright certificate as evidencing Taylor as the sole writer. When Smith took the stand to testify that he had written the song with Taylor, Abeles, by a surprise move, objected to the testimony upon the ground that as Taylor had died Smith could not testify to any personal transaction that he had with Taylor. Abeles relied upon what is known as the New York 'Dead-Man's Statute', which prohibits any person claiming an interest adverse to an estate from testifying to a transaction with the decedent."

A very significant part of Mr. Abeles' statement is to the effect that the decision of the Circuit Court of Appeals has construed the law to be that an author has no right to the renewal term unless he had rights under the original copyright. Mr. Abeles said:

"As to Vogel's further contention, that while Smith might be precluded from asserting any claim to the original copyright this would not defeat his renewal right as co-author, the Circuit Court said that Smith's renewal right depended upon his rights under the original copyright, and that as he had not established his right to the original term he had no authority to obtain a renewal certificate."

And Mr. Abeles concludes with the following:

"The 'Mill Stream' decision has blasted the bonanza of such claimants, in cases where one of the writers

has died. The publisher will now be in a position, as in the 'Mill Stream' case, to introduce the original copyright certificate in evidence, and the claimant will be prohibited from offering his testimony as to his alleged co-authorship. This will greatly curtail the prevalent division of renewals of many of the famous songs that have endured, and will mean a substantial saving to the original publishers."

The decision of the Circuit Court of Appeals is untenable, contrary to and inconsistent with the Copyright Act of 1909 and in complete disregard of the issues presented in this case.

WHEREFORE, petitioner prays that a writ of certiorari may issue out of and under the will of this Court, directed to the United States Circuit Court of Appeals for the Second Circuit, commanding the said Court to certify and send to this Court for review and determination, as provided by law, this cause and a complete transcript of the record and of all proceedings had herein; and that the order of the United States Circuit Court of Appeals affirming the judgment in this cause may be reversed and that the petitioner may have such other and further relief in the premises as this Court may deem proper.

Dated, New York, N. Y., May 12, 1945.

JERRY VOGEL MUSIC CO., INC.,
Petitioner,
By JERRY VOGEL,
President.

ARTHUR F. DRISCOLL,
Solicitor for Petitioner.

STATE OF NEW YORK, }ss.:
COUNTY OF NEW YORK, }

JERRY VOGEL, being duly sworn, deposes and says:

That I am President of Jerry Vogel Music Co., Inc., the petitioner herein. I have read the foregoing petition by me subscribed and know the contents thereof. The facts therein stated are true to the best of my knowledge, information and belief.

JERRY VOGEL

Sworn to before me this
12th day of May, 1945.

MILTON M. ROSENBLUM, Notary Public
Queens Co. Clerk's No. 654, Reg. No. 154-B-6
Bronx Co. Clerk's No. 75, Reg. No. 139-B-6
New York Co. Clerk's No. 199, Reg. No. 245-B-6
Kings Co. Clerk's No. 175, Reg. No. 287-B-6
Commission Expires March 30, 1946



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against

FORSTER MUSIC PUBLISHERS, INC.,

Respondent.

**BRIEF IN SUPPORT OF PETITION FOR
WRIT OF CERTIORARI**

Jurisdiction

The statement of jurisdiction is set forth in the foregoing petition.

Statement of the Case

The facts have been set forth in the foregoing petition.

Specification of Errors

The errors which petitioner will urge if the writ of certiorari is granted are that the Circuit Court of Appeals for the Second Circuit erred:

- (1) In affirming the decree of the District Court and holding that Taylor was the sole author, and, therefore, the plaintiff is the owner of the renewal term of copyright.

(2) In concluding that under Section 55 of the Copyright Law the original certificate of copyright (Ex. 1), in addition to being *prima facie* proof of the facts stated therein, was also *prima facie* proof of sole authorship by Taylor.

(3) In concluding that if Smith had no interest in the original term of copyright he had no right to apply for and to receive a renewal certificate.

(4) In disregarding the pleadings and issues raised and holding that defendant had the burden of proving an affirmative defense, in the absence of such defense in the pleadings.

(5) In holding that Smith's testimony was properly excluded under Section 347 of the New York State Civil Practice Act.

(6) In affirmatively finding that Smith had made no legal or formal claim to the copyright during the first term of copyright. Assuming that there was no other evidence, the exclusion of Smith's testimony under Section 347 left the record barren. The Court was not warranted in making an affirmative finding that Smith had made no claim.

7. In refusing to hold that Smith's testimony was admissible under the exception to Section 347 of the New York State Civil Practice Act. If the admission in evidence of the original copyright certificate containing Taylor's unsworn statement that he was the author of the musical composition for which he made a claim of copyright was accepted as *prima facie* evidence of sole authorship by Taylor, such acceptance was the equivalent of accepting Taylor's testimony, and, therefore, constituted a waiver or exception to the incompetency of the co-author, Smith, to testify under the "Dead Man's Statute".

POINT I

Section 55 of the Copyright Law did not warrant the acceptance of the original copyright certificate as prima facie proof of Taylor's sole authorship of the musical composition.

The essential part of Section 55 provides:

"Said certificate shall be admitted in any Court as prima facie evidence of the facts stated therein."

The facts stated in the certificate (Ex. 1) are:

"1. That two copies of the musical composition named therein were deposited in the Copyright Office under the provisions of the Act of 1909.

"2. That registration of a claim to copyright for the first term of 28 years from the date of publication was made in the name of Taylor for the musical composition—Words and music by Taylor."

The certificate did not, nor could the Register of Copyrights, certify to Taylor's sole authorship. It simply certified that Taylor had filed an unsworn statement that he had written the words and music.

Moreover, the framers of Section 55 could not have intended it to mean that the Register of Copyrights should certify to the truth of a fact of which it was impossible for him to have knowledge. The receipt of Taylor's claim of copyright accompanied by two copies of the musical composition did not involve any determination or investigation by the Register as to whether or not Taylor had actually been the sole author. Therefore, it would be illogical to have the Register certify as to the authorship.

In *Davies v. Bowes*, 219 Fed. 178 (C. C. A. 2), Judge Lacombe said:

"The statement in the certificate that they were received 'as copyright deposits' indicate nothing more

than that they were turned over to the office in attempted compliance with the copyright statute. The receipt of them by the Librarian does not involve any determination by him as to whether or not the deposit is made in time; he is not required to make any investigation when a copy is delivered to him or comes to him by mail as to what was the date of publication."

The certificate at best could be *prima facie* evidence only as far as authorized by Section 55 (*Weil, Law of Copyright*, p. 570).

This Court has not interpreted Section 55, although the need for such interpretation is essential in view of the various decisions of lower courts permitting it to be used in a broader sense than its language warrants.

The unjust effect of the improper use of Section 55 in this case is evident. The result was to deprive Smith, the defendant's assignor, who claimed to be co-author, of his day in court. Smith was held to be incompetent to testify under the provisions of the New York State "Dead Man's Statute" (C. P. A. Sec. 347) because his co-author, Taylor, had in the meantime died. Thus, Smith's right to establish his co-authorship was effectively quashed. By reading into the copyright certificate facts that are not certified to and then by gagging Smith under the "Dead Man's Statute" plaintiff was enabled to secure an injunction against defendant. At the same time the fact that the two copies of the musical composition filed by Taylor with his claim for copyright contained admissions that Smith was a co-author, was wholly ignored.

POINT II

Assuming, arguendo, that Smith had made no claim during the original term of copyright, he was not precluded from making application for the renewal term.

The fundamental structure of the Copyright Law which gives the right to both the author and the proprietor to obtain copyright for the original term definitely reserves the right to the renewal term solely to the author.

There was but one issue presented: Was Smith a joint author? If he was, of course, he was jointly interested in the renewal term of copyright (17 U. S. C. A., Sec. 23).

Either a "proprietor" or an "author" has the right to obtain copyright for the original term (17 U. S. C. A., Sec. 8). The "proprietor" is one who takes title to a work by assignment from the "author" (*Mifflin v. R. H. White*, 190 U. S. 260; *Weil, Law of Copyright*, Sec. 431, p. 168).

But the right to claim a renewal term of copyright is vested solely in the author (17 U. S. C. A., Sec. 23). A proprietor has no such renewal rights. The statute is framed to protect authors, and for that reason the right to the renewal term is vested in the author, irrespective of the disposition of the first term. The intent of Congress in enacting Section 23 was to give to authors the fruits of their labors by means of a separate right in the renewal copyright (*Witmark v. Fisher*, 38 Fed. Supp. 72, aff'd 125 F. [2d] 949, aff'd 318 U. S. 643). The renewal is deemed a separate estate. It is a new grant (*Fox Film v. Knowles*, 261 U. S. 326). A sale of the original copyright carries no interest in the renewal term of copyright unless it is definitely mentioned (*Witmark v. Fisher*, 318 U. S. 643; *Rossiter v. Vogel*, 134 F. [2d] 908).

Therefore, what Smith had done during the original term was immaterial for it could not affect his vested right to the renewal.

In *Witmark v. Fisher*, 318 U. S. 643, at page 654, Mr. Justice Frankfurter said:

"By providing for two copyright terms, each of relatively short duration, Congress enabled the author to sell his 'copyright' without losing his renewal interest. If the author's copyright extended over a single longer term, his sale of the 'copyright' would terminate his entire interest. That this is the basic consideration of policy underlying the renewal provision of the Copyright Act of 1909 clearly appears from the report of the House committee which submitted the legislation (the Senate committee adopted the report of the House committee, see Sen. Rep. 1108, 60th Cong., 2nd Sess.): * * *."

Smith might well have made some deal with Taylor with respect to his interest in the original copyright term, or even have transferred or sold such interest, but that would not affect his right to the renewal term. An author can claim the right of renewal even if he has sold or transferred his manuscript and copyright originally is obtained thereon by the proprietor (*Mifflin v. R. H. White & Co.*, 190 U. S. 260, 262; *Public Ledger v. New York Times*, 275 Fed. 562, aff'd 279 Fed. 747).

The holding of the lower Court that if Smith had no interest in the original term he had no right to apply for and to receive a renewal certificate is without justification in law. It sets up a dangerous precedent which is contrary to the scheme of the copyright statute intended to protect the rights of authors.

POINT III

Smith's testimony was improperly excluded under Section 347 of the New York State Civil Practice Act known as the "Dead Man's Statute" for the following reasons:

A. Under established New York law the testimony was competent and should have been received in support of defendant's denial of plaintiff's affirmative claim.

B. It was admissible under the exception of Section 347 of the New York State Civil Practice Act which waives the incompetency of a witness where the plaintiff places the testimony of the deceased in evidence.

C. Section 347 was intended as a shield not a sword. It was not meant to be used as an instrument of injustice, by the successor to the interest of a deceased person.

A.

The decision of the Circuit Court misconceived the issues presented. It erroneously assumed that defendant had set forth an affirmative defense upon which it had the burden of proof and that Smith's testimony was offered to establish such affirmative defense. The opposite actually was the fact. The Circuit Court said:

" * * * The appellant had the burden of establishing its affirmative defense and we are not persuaded that the District Judge was clearly wrong in holding that it failed to do so" (R. p. 125).

Since defendant had no affirmative defense, it could not possibly in fact or in law have had the burden of proving one. Ownership and sole ownership were part of plaintiff's case. Moreover, plaintiff had alleged that Taylor was the sole author and that Smith was not a co-author.

Defendant had denied the plaintiff's claim and was in the position of offering proof in support of such denial. Smith's testimony actually was offered to negate plaintiff's claim and should have been received. It was competent testimony to overthrow the facts upon which plaintiff's claim of sole ownership rested (*Lewis v. Merritt*, 98 N. Y. 206).

The opinion of the Circuit Court makes it abundantly clear that it upheld the exclusion of Smith's testimony on the theory that defendant had offered it in support of an affirmative defense. The Circuit Court, in referring to *Lewis v. Merritt*, *supra*, said:

" * * * In that case, it was said, however, that Section 347 applies to exclude evidence that will establish a cause of action or an affirmative defense and the latter is the situation here" (R. p. 126).

The foregoing statement of the Circuit Court appears to be a direct concession that, had the issue been correctly appraised, Smith's testimony would have been received. The basic error was the unfounded assumption that it was offered for a purpose other than to negate plaintiff's affirmative claim.

The lower Courts, bound by the doctrine of *Erie R. Co. v. Tompkins*, 304 U. S. 64, were required to follow the construction of the New York State Court of Appeals of Section 347 as set forth in *Lewis v. Merritt*, *supra*. The conclusion is inescapable under such construction that the exclusion of Smith's testimony was reversible error.

B.

Petitioner urged below that the admission in evidence of the original copyright certificate and its acceptance as *prima facie* evidence that Taylor was the sole author of the musical composition was equivalent to accepting the testimony of Taylor and therefore constituted a waiver of the incompetency of Smith.

Section 347, C. P. A., states an exception to the rule of incompetency, as follows:

"where the testimony of deceased is placed in evidence."

The only evidence that Taylor was either co-author or sole author of the musical composition was the registration of his claim to copyright based upon his own statement that he was such author, which registration was certified to in the copyright certificate (Ex. 1).

Smith was prevented from telling his story in rebuttal of such statement.

If the incompetency of a witness to testify to a personal transaction with the deceased is waived when the successor in title of the deceased offers the testimony of the deceased, then defendant at bar should have been allowed, by Smith's testimony, to rebut Taylor's statement of authorship which was accepted as part of the copyright certificate even though unsworn.

Either Taylor's statement should not be considered as of sufficient quality to establish *prima facie* proof of his sole authorship or, in the alternative, it should be considered as within the exception of Section 347 of the New York State Civil Practice Act (*Kings County Trust Co. v. Hyams*, 242 N. Y. 405; *Matter of Boesenberg*, 265 App. Div. 484).

Taylor's claim for copyright was in fact a statement of a personal transaction with Smith. It was a denial by Taylor that Smith was a co-author. Therefore, Smith should not have been prevented from giving the entire transaction or stating his version of what occurred (*Merritt v. Campbell*, 79 N. Y. 625).

C.

The purpose of Section 347 was to prevent undue advantage. It was intended to act as a shield, not a sword (*Lawyers v. White*, 198 N. Y. 318). It was not enacted for the purpose of enabling an estate or the successor of

a deceased to make a claim against another and then prevent such other from answering the charge.

In *Lewis v. Merritt*, 98 N. Y. 206, it is pointed out that the object of Section 829, C. C. P. (now Sec. 347, C. P. A.), will be accomplished if limited to cases which preclude evidence offered for the purpose of establishing an affirmative cause of action or defense.

POINT IV

The exclusion of Smith's testimony having left the record barren of evidence of what Smith did during the original term of copyright, there was no justification for the affirmative conclusion that Smith had made no formal claim.

The plaintiff was not entitled to any favorable inference concerning Smith's actions during the original term in the absence of testimony in that regard. If it were necessary to show Smith had made no formal claim, it was the plaintiff's burden to adduce such proof to establish its claim. The Trial Court seemingly recognized that fact, for it said:

“The plaintiff sues for a declaratory judgment, claiming that one Tell Taylor was the sole author of the song * * *. That Earl K. Smith is not a co-author of the song * * * and therefore has no right to a renewal copyright on the song” (R. f. 332).

Yet the Trial Court inconsistently placed the burden of proving Smith's co-authorship on defendant, making defendant's failure to meet such burden a controlling factor. The Court said:

“The record discloses no evidence that Smith at any time during the lifetime of Taylor ever asserted a formal claim of co-authorship” (R. f. 338).

The Circuit Court, emphasizing the error below, said in its opinion:

" * * * yet the fact that Smith had made no legal or formal claim to the copyright during almost all of the entire 28 years of its original term was a circumstance to be considered by the Court upon the issue of co-authorship by Smith * * *" (R. p. 128).

It is urged that it was wholly immaterial as to what Smith did during the original term, as demonstrated under Point I, infra. The emphasis below on the fact that Smith had made no formal claim, which is unsupported by evidence, is a clear indication of the confusion and misunderstanding by the Courts below of the basic issues presented both in fact and in law.

CONCLUSION

Petitioner therefore prays that a writ of certiorari should be granted in this case.

Respectfully submitted,

**ARTHUR F. DRISCOLL,
Solicitor for Petitioner.**

MILTON M. ROSENBLUM,
on the Brief.



(12) JUN 7 1945

CHARLES ELMORE DROPLEY
CLERK

Supreme Court of the United States

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ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES
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BRIEF FOR RESPONDENT

JULIAN T. ABELES,

EDWIN P. KILROE,

Counsel for Respondent.



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Supreme Court of the United States

OCTOBER TERM, 1944

No. 1283

JERRY VOGEL MUSIC CO., INC.,

Petitioner,

v.

FORSTER MUSIC PUBLISHER, INC.,

Respondent.

BRIEF FOR RESPONDENT

Plaintiff seeks to review a judgment of the Circuit Court of Appeals for the Second Circuit (reported in 147 F. (2d) 614).

None of the Questions of Law Argued by Petitioner Were Involved. The Case Turned Upon a Question of Fact.

Summary of Matter Involved

The action was for a declaratory judgment (a) that one Tell Taylor as the sole author, obtained the exclusive renewal of the copyright in the musical composition entitled "Down By The Old Mill Stream", and that plaintiff as assignee became the sole proprietor of such renewal, and (b) that defendant Earl K. Smith was not a co-author of said musical composition, so that the renewal application filed by him as co-author, and his purported assignment to defendant Jerry Vogel Music Co., Inc., were invalid.

Thus the Trial Court had for determination, and determined, the factual question—was Smith a co-writer of the composition? This plaintiff concedes in its petition (p. 2) "Thus the case proceeded to trial with the issue of authorship being squarely presented * * *, not only that Taylor was the sole author but that Smith was not a co-author. The Trial Court concluded plaintiff was the owner of the renewal term of copyright, holding that Taylor had been the sole author; * * *."

Facts

August 15, 1910. Tell Taylor registered the copyright as the sole writer, *i. e.*, "Words and music by Tell Taylor" (P. Ex. 1).

October 23, 1931. Taylor executed a written assignment of the copyright to respondent, which was recorded in the Copyright Office on December 9, 1931 (P. Ex. 2).

September 1, 1937. Taylor registered his application for the renewal copyright, as the sole writer (P. Ex. 3).

August 11, 1938. The original copyright expired.

August 14, 1937. Petitioner registered an application for the renewal copyright, in the name of Earl K. Smith as an alleged co-author (D. Ex. D).

November 23, 1937. Taylor died (P. Ex. 5).

December 10, 1937. All of Taylor's heirs executed a written assignment of the renewal copyright to respondent, which was recorded in the copyright office on December 16, 1937 (P. Ex. 7).

August 15, 1938. The claim was first asserted of Smith's alleged co-authorship (in a notice sent by petitioner to the trade (R. p. 24)).

March 13, 1939. Neither petitioner nor Smith having instituted any action, their notice of August 15, 1938 so impaired respondent's rights that it was obliged to institute this action.

The Evidence Conclusively Dissipated Petitioner's Claim of Smith's Alleged Co-authorship

(a) On only *one* of the *two* copies filed by Taylor with his application for the original registration (August 15, 1910), Smith's name appeared on only the first sheet of music (apparently stamped) above that of Taylor, but in much smaller letters and without *any indication* that Smith was a co-writer (D. Ex. A). Smith and petitioner having waited for 28 years (until after Taylor's death in 1937) to assert their alleged claim, Taylor's testimony was not available to explain this obvious error.

(b) The title page of the copy bearing Smith's name (in smaller letters above that of Taylor on only the first sheet of music) bears the wording in large type "By Tell Taylor" (D. Ex. A).

(c) The certificate of original copyright registration stated that Taylor was the sole writer of both the "Words and music" (P. Ex. 1).

(d) None of the *nine* editions of the composition published since August 12, 1910 (date of first publication) bore Smith's name (P. Ex. 3). One edition was the same as that of which the two copies were filed by Taylor with his application for registration on August 15, 1910.

(e) Petitioner would have it appear that respondent's evidence was limited to the copyright certificate, and that petitioner was estopped from introducing any testimony of Smith's alleged co-authorship. On the contrary peti-

tioner's claim of Smith's alleged co-authorship was conclusively refuted by the various exhibits (P. Exs. 1-4B, 13; D. Ex. A) and by the testimony of respondent's witnesses Charles Miller (R. pp. 75-84) and Walter W. Goodell (R. pp. 85-91). Furthermore petitioner adduced the testimony of two witnesses, George A. Little (R. pp. 39-50, 91-92) and Bethule A. Healy (R. pp. 50-65). The testimony of both witnesses proved highly unfavorable to petitioner (which obviously accounts for petitioner completely ignoring these witnesses in its brief). Little admitted that Smith's name only appeared in "very fine type" on the first page of music (R. p. 41) of one of the two copies on file in the Register's Office (R. pp. 48, 49); that Smith was not credited as a co-writer because he had only made a minor contribution (a few chords and one line of the lyric (R. p. 47); and that Taylor had always asserted sole authorship (R. p. 49). Healy admitted that she had never met Taylor or Smith until 1918 (eight years after the composition was registered for copyright), so that she could not possibly have any knowledge of Smith's alleged co-authorship (R. pp. 51, 59).

(f) Although the composition has been a very popular song continuously since its first publication in 1910 (R. p. 41), the first claim to Smith's alleged co-authorship was asserted in 1938 (R. p. 24), after Taylor's death in 1937, and no suit was ever instituted by Smith or petitioner to establish such alleged claim.

The Trial Court said in part (R. pp. 113, 114):

"The record discloses no evidence that Smith at any time during the lifetime of Taylor ever asserted a formal claim of co-authorship. The record, however, does disclose that Taylor, or the plaintiff, Forster Music Publishers Inc. as the assignee of Taylor published, from 1910 to 1938, some nine editions of the song, and that in all of these editions, Taylor was indicated as being the sole author. It was also established that Taylor in 1937 filed an appli-

cation for and received the renewal copyright on 'Down by the Old Mill Stream' in his name, as the sole author.

Plaintiff offered the depositions of Charles Miller and Walter Goodell, showing that they were music arrangers and had close business connections with Taylor and Smith, before, during and after the copyrighting, publication and sale of 'Down by the Old Mill Stream', indicating that to their knowledge, Smith never asserted a claim to co-authorship.

The defendant offered the testimony of one Little, a songwriter, and the deposition of Mrs. Healy, a singer, both of whom knew Taylor and Smith. Their testimony appears to be that in the course of conversations with the deceased, they heard him admit that Smith had something to do with the song. But their testimony clearly indicates that Taylor always claimed to be the sole author of 'Down by the Old Mill Stream'.

From all the evidence and exhibits, the only item of any probative value for the defendant's claim of Smith's co-authorship is the fact that Smith's name appears on the filed original copy. In contrast, we have the certificate of copyright issued to Taylor as sole author, his continued assertion of the claim of sole authorship during his entire lifetime, and the publication of nine editions as sole author.

It appears to me that the defendant's one item of probative value is overwhelmed by the evidence adduced by the plaintiff. The plaintiff is therefore entitled to the declaration of rights which it seeks."

POINT I

The certificate of original copyright registration was prima facie evidence under Sec. 55 of the Copyright Law, of Taylor's sole authorship.

Sec. 55 (17 U. S. C.) specifically provides, that the certificate shall state, among other things:

"the name of the author (when the records of the copyright office shall show the same)",

and that,

"Said certificate shall be admitted in any court as prima facie evidence of the facts stated therein."

While petitioner would have it appear to the contrary, one of "the facts stated therein" was that of Taylor's sole authorship of *both* the words and music (P. Ex. 1):

"Musical Composition entitled Down By The Old Mill Stream. Words and music by Tell Taylor."

Petitioner has been unable to cite any Circuit Court decision to support its erroneous argument, for the reason that they have uniformly followed the clear wording of Sec. 55, to the contrary.

POINT II

As Smith was not an author he would have no right of renewal.

The Trial Court found (R. p. 114):

"1. Earl K. Smith was not a co-author of the musical composition entitled 'Down by the Old Mill Stream'."

"2. Tell Taylor was the sole author of the musical composition entitled 'Down by the Old Mill Stream'."

The application for the renewal copyright was filed by petitioner in Smith's name (D. Ex. D) as "One of the Authors".

Sec. 23 of the Copyright Law (17 U. S. C.) provides that "the author of such work, if still living" or those in interest through him "if the author be not living—shall be entitled to a renewal".

As Smith was not an "author" of the composition, obviously he would have no right of renewal as "One of the Authors".

POINT III

The Trial Court properly excluded the testimony of Smith under Sec. 347 of the New York Civil Practice Act, concerning his alleged personal transaction with decedent Taylor.

A. Smith was incompetent to testify under Sec. 347.

Following are the pertinent parts of Sec. 347 (formerly Sec. 829, N. Y. Code of Civil Procedure):

"Upon the trial of an action * * * a party or a person interested in the event, or a person from, through or under whom such a party or interested person derives his interest or title by assignment or otherwise, shall not be examined as a witness in his own behalf or interest, or in behalf of the party succeeding to his title or interest against the executor, administrator or survivor of a deceased person * * * or a person deriving his title or interest from, through or under a deceased person * * * by assignment or otherwise, concerning a personal transaction or communication between the witness and the deceased person * * *, except where the executor, administrator, survivor, * * * or person so deriving title or interest is examined in his own behalf, or the testimony of the * * * deceased person is given in evidence, concerning the same transaction or communication."

Smith's testimony concerning his alleged personal transaction with decedent Taylor was properly excluded because (a) he was interested in the event by reason of his royalty contract with petitioner (D. Ex. E) and petitioner derived its title and interest from him and (b) respondent derived its title and interest through decedent Taylor.

The copyright certificate having established Taylor's sole authorship, petitioner then had the affirmative of establishing its defense of Smith's co-authorship. This

is obviously what the Circuit Court meant when it said, "The appellee established a *prima facie* case by producing the copyright certificate, and while the ultimate burden was upon it to establish its right to a declaratory judgment of sole authorship of the copyrighted publication, the appellant had the burden of establishing its affirmative defense, and we are not persuaded that the District Judge was clearly wrong in holding that it failed to do so."

B. The certificate of copyright registration was not testimony of decedent Taylor constituting a waiver under Sec. 347. It is the settled construction of the New York Court of Appeals that such testimony means the "sworn" statements of the decedent.

Matter of Callister, 153 N. Y. 294, 305, 306:

"Section 829 of the Code * * * makes two exceptions to the general prohibition, viz.: Where the personal representative of the decedent is examined in his own behalf, or the testimony of the deceased person is given in evidence concerning the same transaction or communication. * * * There is a distinction between testimony and evidence, * * * Testimony is personal, for it is the utterance under oath of a person, while evidence may be either documentary or oral. When a carefully drawn statute relating to evidence, aiming to preserve equality and to prevent unfair advantage, speaks of 'the testimony of * * * the deceased person' as 'given in evidence', we think it means by testimony the sworn statements of the deceased made on some prior occasion. (*Lyon v. Ricker*, 141 N. Y. 225, 231.) * * * The promissory note given by John Callister to his wife was evidence, but it was not the testimony of a deceased person. It would be a loose and dangerous construction to hold that when an instrument executed by a dead man is read in evidence by those who represent him, the living party to the document can testify to whatever was said and done when it was executed."

In *Matter of Seigle*, 289 N. Y. 300, 302, 303, the Court of Appeals cited and followed its prior determination in *Matter of Callister, supra*. The case is precisely in point, the Court saying that although certain checks executed by decedent and offered in evidence by the executors raised a presumption of payment of a promissory note, testimony was correctly excluded under Sec. 347, which sought to prove that the checks "were given by decedent for a purpose other than the payment of the note."

None of the cases cited by petitioner have any application.

In *Matter of Boesenberg*, 265 App. Div. 484, there were offered "self serving declarations * * * for the purpose of establishing an offer by the deceased husband to resume marital relations with his wife". The Court said that it was improper for the Surrogate to have considered such self serving declarations "as establishing the matters therein set forth."

In both *Kings County Trust Co. v. Hyams*, 242 N. Y. 405 and *Merritt v. Campbell*, 79 N. Y. 625, plaintiff had made defendant its own witness as to the same personal transaction in respect to which defendant's testimony was subsequently offered.

In *Lewis v. Merritt*, 98 N. Y. 206, plaintiff's executor waived the privilege by being examined in his own behalf, as to the same personal transaction in respect to which defendant's testimony was subsequently offered.

In *Lawyer v. White*, 198 N. Y. 318, the testimony concerned only "evidence of facts not constituting the transaction and not proving any communications between the parties, and which had nothing to do with the negotiations".

Petitioner's argument under Point IV of its brief merely a repetition of its argument under Point III and B, and has been answered under Point III A and *supra*.

The application should be denied.

Respectfully submitted,

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